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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/506,486

09/02/2004

Klaus Poellmann

2002DE408

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25255

7590

02/21/2008

CLARIANT CORPORATION
INTELLECTUAL PROPERTY DEPARTMENT
4000 MONROE ROAD
CHARLOTTE, NC 28205

EXAMINER

MCAVOY, ELLEN M

ART UNIT

PAPER NUMBER

1797

MAIL DATE

DELIVERY MODE

02/21/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/506,486	Applicant(s) POELLMANN ET AL.	
	Examiner Ellen M. McAvoy	Art Unit 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/15/2004</u> . | 6) <input type="checkbox"/> Other: ____. |

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Corr et al (6,849,583) and Ohsumi et al (6,936,576), considered separately.

Corr et al ["Corr"] disclose a refrigeration lubricant composition for use in a refrigeration system with a refrigerant comprising a synthetic lubricant and an amphiphilic anti-deposition component. The refrigerant may be carbon dioxide. See column 2, lines 55-65. The synthetic lubricant includes polyol ester oils and polyoxyalkylene glycol oils. Corr teaches that a preferred polyoxyalkylene glycol lubricant may be represented by one or more compounds of general formula (I) set forth in column 9, lines 38-41, which contains both oxyethylene and oxypropylene groups. Substituent A is the residue remaining after removing the hydroxyl groups from a hydroxyl containing organic compound. Corr teaches that a suitable hydrocarbyl group for substituent A includes resorcinol. See column 10, lines 25-28. The examiner is of the position that the polyoxyalkylene glycol lubricant of Corr meets the limitations of the base oil of the claims when substituent R¹ of the claims is a radical derived from resorcinol. Although pyrogallol or 1,2,3-trihydroxybenzene is not specifically set forth in the prior art, the examiner is of the position that such aromatic polyhydric compounds are suitable as substituent A.

Ohsumi et al ["Ohsumi"] disclose a refrigerating machine oil for a carbon dioxide refrigerant comprising a polyalkylene glycol represented by general formula (I) in the abstract

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and in column 2, lines 18-20, wherein R^1 represents a residue of an organic compound having one to ten hydroxyl group(s) from which the hydroxyl group(s) have been removed, and substituent R^2 is an alkylene group of 2 to 4 carbon atoms. Ohsumi teaches that organic compounds suitable for R^1 include aromatic dihydric alcohols such as resorcinol. See column 5, lines 57-64. Thus, the examiner is of the position that the polyoxyalkylene glycol lubricant of Ohsumi meets the limitations of the base oil of the claims when substituent R^1 is a radical derived from resorcinol. Ohsumi discloses many other polyhydric compounds suitable for R^1 including aromatic polyhydric compounds. Although pyrogallol or 1,2,3-trihydroxybenzene is not specifically set forth, the examiner is of the position that such aromatic compounds are suitable as substituent R^1 .

Claim Rejections - 35 USC § 103

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over McGraw et al (4,851,144).

McGraw et al ["McGraw"] disclose a lubricant base oil composition for compression refrigeration comprising (A) 95 to 5% by weight of polyether polyols represented by the formula in column 2, lines 11-14, wherein substituent Z is a residue of a compound having 1-8 active hydrogens, and (B) 5 to 95% by weight of synthetic esters. McGraw teaches that substituent Z includes dihydric phenolic compounds including resorcinol and pyrogallol. The examiner is of the position that the polyether polyol compound of the prior art meets the limitations of the lubricant comprising a compound of formula (I) of claim 8 when substituent Z is the dihydric phenolic compounds resorcinol and pyrogallol.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen M. McAvoy whose telephone number is (571) 272-1451. The examiner can normally be reached on M-F (7:30-5:00) with alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ellen M McAvoy/

Ellen M McAvoy
Primary Examiner
Art Unit 1797

EMcAvoy
February 6, 2008